

REMARKS

In the Action, claims 1-20 are pending. Upon entry of the present amendment, these claims remain pending, claim 1 is amended, and new independent claim 21 is added. No new matter is added.

In the Action, claims 1-20 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. These claims also stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse these rejections.

Claim Rejections - 35 U.S.C. § 101

In alleging that claims 1-20 fail to recite statutory subject matter, the Action makes two assertions: 1) that the claims do not fall within any of the classes of statutory subject matter set forth in 35 U.S.C. §101; and 2) that the claims recite a mere abstract idea, with no useful, tangible, concrete results. In doing so, the Action emphasizes the fact that the preamble to independent claim 1 recites “guiding a business.” Action, pp. 2-3. Applicants respectfully submit that neither of these assertions holds true.

As for the first assertion, pending claims 1-20 are method claims. Applicants respectfully submit that methods are among the statutory classes of subject matter (i.e., as a “process”), and respectfully request reconsideration of the Action’s assertion that the claim 1 method is not in a statutory class.

Given the Action’s emphasis on the “business” language in the claim, the Action appears to be applying the judicially-created “business method” exception to statutory subject matter, to allege that the particular recited process is ineligible for patent protection because it is a “business method.” The “business method” exception has been disavowed by the courts,

and “business method” claims are to be treated just like any other method claim when considering patentability (the fact that they are “business methods” does not detract from their patentability). See, e.g., State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596, 1602 (Fed. Cir. 1998) (“As an alternative ground for invalidating the '056 patent under Section 101, the court relied on the judicially-created, so-called “business method” exception to statutory subject matter. We take this opportunity to lay this ill-conceived exception to rest. ... Since the 1952 Patent Act, business methods have been, and should have been, subject to the same legal requirements for patentability as applied to any other process or method.”). The fact that the preamble mentions a “business” use is irrelevant to the determination of whether the method is of a statutory class.

The Action’s second assertion alleges that the recited claim 1 method is a mere abstract idea that does not produce a useful, tangible, concrete result. Action, p. 3. Again, Applicants respectfully disagree. In determining whether a recited method produces such a result, one must consider the claim as a whole, and not just an isolated phrase. See AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447, 1451 (Fed. Cir. 1999) (“Thus, the Alappat inquiry simply requires an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a “law of nature” or an “abstract idea,” or if the mathematical concept has been reduced to some practical application rendering it ‘useful.’”). When claim 1 is considered as a whole, it is clear that the claim does not merely recite an abstract idea. For example, amended independent claim 1 recites the following additional language: “said first stage approach including the steps of presenting an initial customer interface and gathering customer feedback” and “said second stage approach including the step of refining said

customer interface based on said customer feedback.” These are tangible, useful, concrete results. Furthermore, the original claim itself recited its concrete, tangible, and useful result: “at least one of maturing the business and guiding the business to an initial public offering readiness state.” Both maturing the business and guiding the business to an initial public offering readiness state are concrete, tangible, useful results – they are clearly not merely descriptive of laws of nature or pure mathematical concepts.

Applicants respectfully submit that claim 1 recites statutory subject matter. As for dependent claims 2-20, those claims are also each rejected in the Action as being directed towards non-statutory subject matter, but the Action does not identify any language from those claims that serve as a basis for those rejections, and as such, Applicants can only assume that the rejection of these dependent claims is due to the language recited in independent claim 1. If that is the case, then Applicants submit that, in addition to the discussion above regarding the language of claim 1, these dependent claims add yet more “tangible, concrete and useful” results to the claim, making it all the more clear that these claims do not merely recite “abstract ideas.” Accordingly, Applicants respectfully submit that dependent claims 2-20 also recite statutory subject matter.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 1-20 also stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In making this rejection, the Action addresses only the preamble to claim 1, alleging that the preamble fails to clearly set forth the scope of the claimed invention, thereby rendering the claim indefinite. Action, p. 4. Applicants disagree. The preamble, by itself, is not intended to set forth the scope of the entire claimed invention. “The claim preamble must

be read in the context of the entire claim.” MPEP 2111.02. When the claim is read as a whole, the claim’s scope is clear. The explicitly recited steps of claim 1 are part of the “method for guiding a business,” and at a minimum, those steps must be considered in order to clearly understand the claim’s scope.

Furthermore, Applicants are unaware of any statutory requirement that the preamble must define the scope of the claimed invention, particularly since preambles are often not even considered limitations to a claim. See, e.g., Tegal Corp. v. Tokyo Electron America Inc., 59 USPQ2d 1385, 1395 (Fed. Cir. 2001) (“Preambles are not necessarily limiting. Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (stating that a preamble is limiting when it is ‘necessary to give life, meaning and vitality to the claims or counts’).”).

Regardless of whether or not the preamble of independent claim 1 is limiting in this case, Applicants therefore respectfully submit that claim 1 would be well understood by those of ordinary skill in the art, and that the claim is not indefinite. Claims 2-20 depend from claim 1, and stand rejected under the same rationale applied to claim 1, so for the reasons set forth above with respect to claim 1, Applicants submit that claims 2-20 are also not indefinite.

New Independent Claim 21

New independent claim 21 recites the following:

A method, comprising the steps of:

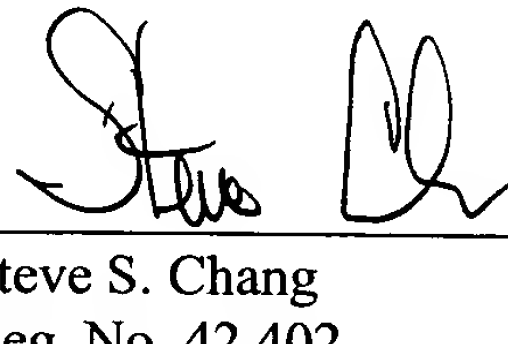
- a) performing a first stage step for launching a business, said first stage step resulting in launching said business, and including a step of using one or more disposable solutions; and
- b) performing a second stage step for at least one of maturing the business and guiding the business to an initial public offering readiness state, said second stage step including a step of replacing said one or more disposable solutions with a new architecture.

Applicants submit that this claim is directed towards novel, statutory subject matter, and is in condition for allowance.

Conclusion

Applicants respectfully submit that pending claims 1-21 are directed towards novel, statutory, and definite subject matter, and that they are in condition for allowance. If the Examiner believes that additional discussion and/or amendment is needed to place the application in condition for allowance, the Examiner is invited to telephone Applicants' undersigned representative at the number appearing below.

Respectfully submitted,



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